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09/665,667	09/20/2000	Takaharu Kitada	SON-1905	5559

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EXAMINER

NGUYEN, KIMBERLY D

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/665,667
Filing Date: September 20, 2000
Appellant(s): KITADA, TAKAHARU

Ronald P. Kananen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 22 September 2003.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-2, 6, 10, 15-16 and 18-19; claims 3 and 17; claim 4; claims 5, 7 and 11-14; claims 8-9; and claim 20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,193,160	Zembitski	2-2001
5,898,370	Reymond	4-1999
5,367,148	Storch et al	11-1994
5,959,531	Gallagher, III et al	9-1999
6,012,641	Watada	1-2000
6,089,456	Walsh et al	7-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-2, 6, 10, 15-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zembitski (US 6,193,160; hereinafter "Zembitski") in view of Reymond (US 5,898,370; hereinafter "Reymond").

Zembitski teaches an information processing system (fig. 7) comprising: an information providing medium 60B that stores information in an electromagnetic or optical manner, the information providing medium being attached to an entity 6B in order to provide information associated with the entity 6B (fig. 4; col. 10, lines 61-67); a hand-held terminal device 5 having an information read function for reading the information from the information providing medium in an electromagnetic or optical manner and recording the information therein (fig. 3b; col. 7, lines 40-59); and an information processing unit CPU for retrieving the information recorded in the hand held terminal device and processing the information therein (fig. 7; col. 13, line 64 through col. 14, line 15).

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Zembitski is silent with respect to the information-providing-medium/label, which is inconspicuously attached to the entity.

Reymond teaches a radio tag wherein the tag is inconspicuously attached to the entity (abstract; col. 2, lines 20-26).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known radio tag which is inconspicuously attached to an entity as taught by Reymond to the teachings of Zembitski in order to prevent an unauthorized manipulation and/or tempering of the radio tag by the vendee. Thus, the modification would have provided Zembitski with an enhance security means for preventing any theft and/or removing the entity without making the payment, etc.

2. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zembitski as modified by Reymond as applied to claim 1 above, and further in view of Storch et al. (US 5,367,148; hereinafter "Storch"). The teachings of Zembitski as modified by Reymond have been discussed above.

Zembitski/Reymond teaches an information processing system with an information providing medium, a hand held terminal and an information processing unit.

Zembitski/Reymond is silent with the information processing unit, which is adopted to discriminate whether the information read from the hand held terminal device is genuineness or counterfeit.

Storch teaches counterfeit/genuineness objects, which can be detected by checking associated ID numbers, which include one or more appended fields in a database containing the

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correct authorized ID numbers (see figs. 1-4; col. 10, line 4 through col. 11, line 43; and col. 11, line 62 through col. 12, line 10).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known counterfeit/genuineness detection system as taught by Storch to the teachings of Zembitski/Reymond in order to insure counterfeit product is detected and to further protect a manufacturer from losing sale on their original/genuineness product.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zembitski as modified by Reymond as applied to claim 1 above, and further in views of Gallagher, III et al. (US 5,959,531; hereinafter "Gallagher") and Watada (US 6,012,641; hereinafter "Watada"). The teachings of Zembitski as modified by Reymond have been discussed above.

Zembitski teaches an information processing system with an information providing medium, a hand held terminal and an information processing unit.

Zembitski/Reymond is silent with respect to the information providing medium, which comprises a film shaped substrate, an IC chip provided at the substrate in order to store information associated with the entity, and an antenna body connected to the IC chip.

Gallagher teaches a radio frequency identification (RFID) tag system, wherein the intelligent tag comprises an IC chip and an antenna body connected to the IC chip (see fig. 4; col. 6, lines 12-52).

Watada teaches a plastic card with a laminate of a plurality of sheets of a stretched polyester film substrate, which the desired shape of the card is not particularly limited (see fig. 4a-4b; col. 4, line 53 through col. 5, line 4).

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It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known intelligent tag system as taught by Gallagher, and a plastic card with laminate of polyester film substrate as taught by Watada to the teaching of Zembitski/Reymond in order to incorporate the mechanical strength, dimensional stability, heat resistance and intellectual functionality (IC chip) to the information providing medium.

4. Claims 5, 7 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zembitski as modified by Reymond as applied to claims 1 and 10 above, and further in view of Walsh et al. (US 6,089,456; hereinafter "Walsh"). The teachings of Zembitski as modified by Reymond have been discussed above.

Re claims 5 and 11: Zembitski teaches an information processing system, where the hand held terminal device comprises at least an antenna body 54 for being coupled with the information providing medium in an electromagnetic manner, information read means for reading information associated with the entity from the antenna body (see fig. 3b; col. 9, lines 52-59).

Zembitski/Reymond is silent with respect to the hand held terminal device with a non-volatile storage for storing the information read from the information read means.

Walsh teaches a hand held device, which has a memory storage PROM, where PROM is served as non-volatile storage memory/means (see col. 3, lines 37-55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known hand held device with a non-volatile memory storage (e.g., PROM) and an information read function as taught by Walsh

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to the teaching of Zembitski/Reymond in order to improve the information holding/processing functionality of the hand held device.

Re claims 7 and 12-14: Zembitski/Reymond is silent with respect to the hand held cellular phone having its information read function.

Walsh teaches a hand held cellular phone system 120, which comprises an information read function (fig. 8; see col. 1, line 65 through col. 2, line 25; col. 3, lines 37-55; and col. 29, lines 6-26).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known hand held cellular phone device with an information read function as taught by Walsh to the teaching of Zembitski/Reymond in order to provide a versatile and compact cellular-phone/label-reader system, which provide greater convenience to the users for carrying a single device rather than a plurality of devices.

5. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh in view of Reymond.

Walsh teaches a hand held cellular phone 120 for reading information from an information providing medium 614 attached to an entity, the hand held cellular phone comprising: a telephone function; information read means for reading information associated with the entity from the information providing medium 614; and non-volatile storage means for storing information read from the information read means (fig. 8; col. 2, lines 43-58; col. 3, lines 37-55; col. 5, lines 13-49).

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Walsh is silent with respect to the information providing medium, which is inconspicuously attached to the entity.

Reymond teaches a radio tag wherein the tag is inconspicuously attached to the entity (abstract; col. 2, lines 20-26).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known information providing medium/label being inconspicuously attached to the object as taught by Reymond to the hand held cellular phone device with an information read function as taught by Walsh in order to prevent an unauthorized manipulation and/or tempering of the radio tag by the vendee. Thus, the modification would have provided Zembitski with an enhance security means for preventing any theft and/or removing the entity without making the payment, etc.

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zembitski in view of Reymond and Storch.

Zembitski teaches an information processing system (fig. 7) comprising: an information providing medium 60B that stores information in an electromagnetic or optical manner; a hand held terminal device 5 having an information read function for reading the information from the information providing medium in an electromagnetic or optical manner and recording the information therein (fig. 3b; col. 7, lines 40-59); and an information processing unit for retrieving the information recorded in the hand held terminal device (fig. 7; col. 13, line 64 through col. 14, line 15).

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Zembitski is silent with respect to the information providing medium being attached to an entity in order to provide information identifying the entity as genuine; and wherein the information providing medium is inconspicuously attached to the entity.

Storch teaches counterfeit/genuineness object, which can be detected by checking associated ID numbers from the label, which is attached to the object (see figs. 1-4; col. 10, line 4 through col. 11, line 43; and col. 11. 62 through col. 12, line 10).

Reymond teaches a radio tag wherein the tag is inconspicuously attached to the entity (abstract; col. 2, lines 20-26).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known radio tag which is inconspicuously attached to an entity as taught by Reymond and the counterfeit/genuineness detection system as taught by Storch to the teachings of Zembitski in order to prevent an unauthorized manipulation and/or tempering of the radio tag by the vendee. Thus, the modification would have provided Zembitski with an enhance security means for preventing any theft and/or removing the entity without making the payment, etc.

(11) Response to Argument

Regarding claims 1-2, 6, 10, 15-16 and 18-19: In response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., "In contrast, the claimed invention retrieves more than just an ID, but other information about the scanned object from the scanned object." (page 8, 4th paragraph)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van*

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Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner respectfully requests the appellant to further review the claimed language in the claims, for example claim 1 recites that “an **information** providing medium that stores **information** in an electromagnetic or optical manner, the information providing medium being attached to an entity in order to provide **information** associated with the entity”, wherein given its broadest reasonable interpretation, the “information” can be any thing about the object.

In response to appellant's argument that there is no suggestion to combine the references (e.g. “Obviousness cannot be established by combing the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination...” (page 8, 6th paragraph)), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Zembitski teaches an information providing medium (barcode 60B in fig. 4) that stores information in an optical manner, the information providing medium (barcode 60B in fig. 4) being attached to an entity (6B in fig. 4) in order to provide information associated with the entity (6B in fig. 4). However, Zembitski does not specifically teach the information providing medium (6B in fig. 4), which is inconspicuously attached to the entity. On the other hand, Reymond teaches a radio frequency tag, which is inconspicuously attached to the entity (abstract; col. 2, lines 20-26). It would have been obvious to combine Reymond's radio frequency tag, which is inconspicuously attached to the entity to

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the teachings of Zembitski in order to prevent an unauthorized manipulation and/or tempering of the tag by the vendee and/or to maintain the original aesthetic look of the entity without the attachment of the information providing medium/tag on the entity.

Regarding claims 3 and 17: In response to appellant's argument that there is no suggestion to combine the references (e.g. "Storch et al. '148 discloses or suggests that bar codes can be used to identify counterfeit products, by using numbers in the bar codes having random portions... Accordingly, even if Storch et al. '148 is combined with Zembitski '160 and Reymond '370, either alone or in combination, the resulting apparatus would be inoperable. Accordingly, there is no motivation to combine the references." (page 10, 1st paragraph)), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Zembitski teaches an information providing medium (barcode 60B in fig. 4) that stores information in an optical manner, the information providing medium (barcode 60B in fig. 4) being attached to an entity (6B in fig. 4) in order to provide information associated with the entity (6B in fig. 4); a handheld terminal (5 in fig. 4 (col. 7, lines 40-59)) and an information processing unit (CPU (col. 14, lines 1-15)). Reymond teaches a radio frequency tag, which is inconspicuously attached to the entity (abstract; col. 2, lines 20-26). However, Zembitski as modified by Reymond fails to specifically teach the information processing unit, which is adapted to discriminate whether the information read from the handheld device is genuineness or

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counterfeit. Storch teaches counterfeit/genuineness objects/tags, which can be detected/discriminated by checking the bar coded ID numbers, which include one or more appended fields in a database containing the correct authorized ID numbers (see col. 11, lines 3-31 and col. 11, line 62 through col. 12, line 10). It would have been obvious to incorporate the discriminating genuineness or counterfeit through a bar-coded information-providing-medium as taught by Storch to the teachings of Zembitski as modified by Reymond in order to protect the original/genuineness product from being modified or duplicated.

Regarding claims 8-9: In response to appellant's argument that there is no suggestion to combine the references (e.g. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination... In this case, there is no motivation to combine Reymond '370 with Walsh et al. '456, as Walsh et al. '456 teaches using a scanner that needs to have the label knowingly it its' line of sight..." (page 12, 2nd paragraph)), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Walsh teaches a hand held cellular phone (120) for reading information from an information providing medium (614) attached to an entity, the hand held cellular phone comprising: a telephone function; information read means for reading information associated with the entity from the information providing medium (614); and non-volatile storage means for storing information read from the information

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read means (fig. 8; col. 2, lines 43-58; col. 3, lines 37-55; col. 5, lines 13-49). However, Walsh does not specifically teach the information providing medium (614), which is inconspicuously attached to the entity. Reymond teaches a radio tag, which is inconspicuously attached to the entity (abstract; col. 2, lines 20-26). It would have been obvious to combine Reymond's radio frequency tag, which is inconspicuously attached to the entity to the teachings of Walsh in order to prevent an unauthorized manipulation and/or tempering of the tag by the vendee and/or to maintain the original aesthetic look of the entity without the attachment of the information providing medium/tag on the entity.

Regarding claim 20: In response to appellant's argument that "It can be readily seen that claim 20 incorporates the elements of providing information identifying the entity as genuine, as well as the information providing medium being inconspicuously attached to the entity. As discussed above, neither Zembiski '160 or Reymond '370, either alone or in combination, disclose, teach or suggest a system as claimed where the information providing medium is inconspicuously attached to the entity and that the information providing medium provides information identifying the entity as genuine. Accordingly, claim 20 is allowable." (page 13, 3rd paragraph). In this case, Zembitski teaches an information processing system (fig. 4) comprising: an information providing medium (barcode 60B in fig. 4) that stores information in an optical manner; a hand held terminal device (5 in figs. 4 and 7) having an information read function for reading the information from the information providing medium in an optical manner and recording the information therein (fig. 3b; col. 7, lines 40-59); and an information processing unit for retrieving the information recorded in the hand held terminal device (fig. 7; col. 13, line 64 through col. 14, line 15). However, Zembitski does not teach the information

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providing medium being attached to an entity in order to provide information identifying the entity as genuine; and wherein the information providing medium is inconspicuously attached to the entity. Reymond teaches a radio tag wherein the tag is inconspicuously attached to the entity (abstract; col. 2, lines 20-26). It would have been obvious to combine Reymond's radio frequency tag, which is inconspicuously attached to the entity to the teachings of Zembitski in order to prevent an unauthorized manipulation and/or tempering of the tag by the vendee and/or to maintain the original aesthetic look of the entity without the attachment of the information providing medium/tag on the entity. However, Zembitski as modified by Reymond fails to teach or fairly suggest the information providing medium being attached to an entity in order to provide information identifying the entity as genuine. Storch teaches counterfeit/genuineness object, which can be detected by checking associated ID numbers from the label, which is attached to the object (see figs. 1-4; col. 10, line 4 through col. 11, line 43; and col. 11. 62 through col. 12, line 10). It would have been obvious to incorporate the discriminating genuineness or counterfeit through a bar-coded information-providing-medium as taught by Storch to the teachings of Zembitski as modified by Reymond in order to protect the original/genuineness product from being modified or duplicated.

For the above reasons, it is believed that the rejections should be sustained.

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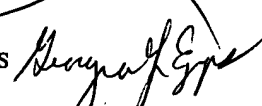
Respectfully submitted,

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October 28, 2004

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